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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,665	08/31/2001	Shinji Tai	213446US0	7812
22850	7590	03/30/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			WYROZEBSKI LEE, KATARZYNA I	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1714

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,665

Applicant(s)

TAI ET AL.

Examiner

Katarzyna Wyrozebski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15,16,18-29 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15,16,18-29 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Applicant's response dated 12/29/2004 is considered and not found persuasive, since unexpected results cannot overcome double patenting rejection. The examiner is also issuing second non-final office action, since all patents that are utilized in ODP rejections should have been utilized as a 102 anticipations rejections as well.

### ***Double Patenting***

Double Patenting rejections of record are not overcome and are incorporated here by reference.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 15, 16, 18-29, 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by TAI (US 5,599,598)

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The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Patented invention '598 discloses composition having gas barrier properties. The composition comprises a thermoplastic polymer (claim 1) having carbon-carbon double bond, and ethylene-vinyl alcohol polymer having ethylene content of 5-60 mol% and saponification degree of 90% or more (claim 7). The composition further comprises transition metal salt such as iron, nickel, copper, manganese and cobalt (claim 8). The salts are utilized in amount of 1-5000 ppm.

The article formed from the composition above is a multilayered container (claim 17). According to further claim 15 the other layers of the multilayered article are made of polyester.

In the light of the above disclosure, TAI anticipates claims rejected above.

3. Claims 15, 16, 18-29, 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by TAI (US 6,759,107)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

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inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Already patented invention '107 discloses composition comprising thermoplastic resin, transition metal salt in amount of 1-5000 ppb (claim 1) and ethylene-vinyl alcohol polymer having ethylene content of 3-60 mol% and saponification degree of 90% or more (claim 7). The thermoplastic polymer is copolymer of styrene and diene that satisfies the claims of the present invention.

Article formed from the composition of '107 is a multilayered article, such as film or container (claims 13-14), which contains additional layers made from polyester (claim 16).

In the light of the above disclosure, prior art of TAI anticipates claims rejected above.

In the response dated 12/29/2005 the applicants argued following:

a) The prior art of TAI does not disclose the upper limit of the degree of saponification of EVA.

With respect to the above argument, applicants claim call for degree of saponification of  $90 \leq SD \leq 99 \%$ , therefore if the degree of saponification of EVA in the prior art of TAI is at least 90 % then its upper limit cannot really go higher than 100%. However, if the applicants insist, the specification of the prior art of TAI further defines the saponification as being at least 90 % preferably 95 %, even more preferably 97%, wherein all of the ranges are within applicant's limitations.

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b) Applicants have provided experimental results as means to overcome the rejections. With respect to the above documentations, although insightful unexpected results cannot be used to overcome double patenting rejection and now 102 anticipation rejections.

c) Applicants stated that the prior art of TAI fails to teach the improvements of adhesion with resin having degree of saponification of  $90 \leq SD \leq 99 \%$ .

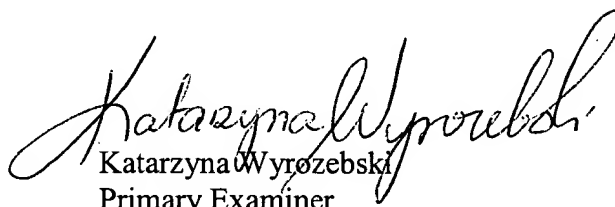
With respect to the above argument, instant claim discloses a composition and not improvement for adhesion; therefore the argument is not commensurate with the scope of the claim. In addition, as evidenced by the specification of both disclosures of TAI there is really no difference between the degree of saponification of EVA of the present invention and that disclosed in the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Katarzyna Wyrozebski  
Primary Examiner  
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March 16, 2005